REMARKS

Applicants submit these Remarks in reply to the Office Action mailed February 29, 2008. Claims 1-25, 28, and 29 are pending in this application, of which claims 1, 21, 28, and 29 are independent. Applicants have amended claims 1, 21, 23, 28, and 29 as provided above. By this Amendment, no new matter has been introduced.

In the Office Action, the Examiner took the following actions:

(1)   rejected claims 21-24 and 29[1] under 35 U.S.C. § 102(a) as being anticipated by PCT Patent Application Publication WO 03/005192 ("*Reimer*");

(2)   rejected claims 1-8, 10, 12-20, and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2003/0140267 ("*Abbondanzio*") in view of *Reimer*;

(3)   rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Reimer* in view of *Abbondanzio*;

(4)   rejected claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Reimer* in view of U.S. Patent Application Publication 2004/0255191 ("*Fox*"); and

(5)   rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Abbondanzio* in view of *Reimer* and further in view of U.S. Patent Application Publication 2003/0046394 ("*Goddard*");

Applicants respectfully traverse these rejections, as follows.

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[1] The Examiner only listed claims 21-24 as rejected under 35 U.S.C. § 102(a), but included claim 29 in the analysis.

I.   35 U.S.C. § 102(a)

Applicants respectfully traverse the Examiner's rejection of claims 21-24 and 29

under 35 U.S.C. § 102(a), because *Reimer* does not anticipate those claims, as

amended. To establish that *Reimer* anticipates Applicants' claims under 35 U.S.C. §

102(a), the Examiner must show that *Reimer* discloses the "identical invention . . . in as

complete detail as is contained in the . . . claim." *See* M.P.E.P. § 2131, quoting

Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed.

Cir. 1989). Additionally, the "elements must be arranged as required by the claim." *See*

M.P.E.P. § 2131, citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

As shown below, *Reimer* does not disclose the identical invention as claimed, and

Applicants respectfully traverse the rejection.

A.   *Reimer* does not disclose "testing the service in parallel operation on the first computer and on the second computer, and disabling the operation of the service by the first computer only if the test is successful."

Amended independent claim 21 recites, among other things, "testing the service

in parallel operation on the first computer and on the second computer, and disabling

the operation of the service by the first computer only if the test is successful."[2] *Reimer*

does not disclose this subject matter. However, in the Office Action, the Examiner cited

Reimer as allegedly disclosing this recitation in the following:

> When the spare server is up and running, any new users requiring the
> second type of 25 operating system for the first type of applications, i.e.
> API(OS2), are directed to server S5 by the load balance unit, which is
> controlled by the control unit CU via the monitoring unit MU. No new users
> are directed to the failing server S3.

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[2] Prior to the amendment, this recitation was substantially recited in dependent claim
23.

Reimer, p. 16, II. 24-28.

However, *Reimer* is silent with regard to "testing the service in parallel operation," as claimed by Applicants. Instead, as exemplified in the cited passage, *Reimer* discloses directing users away from a failed server. *Id.* Such disclosure does not anticipate or render obvious Applicants' claim recitation.

Similarly, *Reimer* is also totally silent with regard to "disabling the operation of the service by the first computer only if the test is successful," as recited in amended claim 21. Indeed, *Reimer* does not disclose performing any test of the service.

For at least these reasons, *Reimer* does not disclose, teach, or suggest all recitations of Applicants' amended independent claim 21.

B. ***Reimer* does not disclose "cyclically repeating the shifting and re-installing for all computers in the group, thereby keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system."**

Amended independent claim 29 recites "cyclically repeating the shifting and re-installing for all computers in the group, thereby keeping the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system." *Reimer* does not disclose this recitation.

In support of the rejection, the Examiner cites *Reimer*, p. 14, II. 5-7, which states "send an order to the load balance unit, via the monitoring unit, to direct new users to an alternative server having the same operating system as the server being shut down." This disclosure relates to directing users away from a server being shut down, but clearly has no bearing on Applicants' claim recitation. In fact, the very next sentences in *Reimer* state:

> <u>If no alternative server is available</u>, the control unit may boot a spare server (not shown), by using the process described in connection with figure 5, to create a server with the same preconfigured operating system as the one that should be shut 10 down and rebooted. <u>If there is no spare server available, new users will be denied access to any server</u> until the server is rebooted.

Reimer, p. 14, ll. 7-11 (emphasis added).

Therefore, *Reimer* does not "[keep] the number of computers that are re-installing the operating system smaller than the number of computers that are not re-installing the operating system," as recited in Applicants' amended claim 29. Instead, *Reimer* contemplates a system where no computers remain available for access during the reinstallation process. *Id.*

Consequently, *Reimer* does not disclose, teach, or suggest all recitations of Applicants' amended independent claim 29.

C. The 35 U.S.C. § 102(a) rejections should be withdrawn.

As shown above, *Reimer* does not disclose at least one recitation of independent claims 21 and 29. Because Applicants' dependent claims 22-24 each necessarily contain the recitations of independent claim 21, *Reimer* also does not disclose all recitations of those claims. Consequently, Applicants respectfully request that the Examiner withdraw the 35 U.S.C. § 102(a) rejections based on *Reimer* with respect to claims 21-24 and 29.

II. 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejections of claims 1-20 and 25-28 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. *See* M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences <u>themselves</u> would have been obvious, but whether the claimed invention <u>as a whole</u> would have been obvious." M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

"[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established with regard to claims 1-20 and 25-28, as amended, because the Examiner has not properly explained

why the differences between Applicants' claims and the prior art would have been

obvious to one of ordinary skill in the art.

A.   The references do not teach "automatically configuring the operating system based on a configuration used in an earlier detected blade."

Applicants' amended independent claims 1 and 28 recite, among other things,

"copying a service that is running on the earlier detected blade to the new blade." The

Examiner correctly states that *Abbondanzio* does not teach this recitation. However,

Reimer also does not teach this recitation. The previously-cited passage of *Reimer* is

replicated below in its entirety:

> If a privileged user has access to the server, <u>the user may request</u> a change of pre-configured operating system, thereby causing the control Unit CD to select the desired <u>preconfigured</u> operating system and rebooting the server after the user has logged out from the server.

Reimer, p. 13, ll. 12-16 (emphasis added).

As the cited passage reveals, *Reimer* does not teach or suggest "configuring the

operating system based on a configuration used in an earlier detected blade," as

claimed by Applicants. Instead, the passage reveals that the operating system in

Reimer is already preconfigured before installation. Indeed, *Reimer* is silent with regard

to Applicants' claim recitation.

In addition, *Reimer* also does not teach or suggest "automatically configuring the

operating system," as claimed by Applicants. Instead, *Reimer* discloses "<u>the user may</u>

<u>request</u> a change of the pre-configured operating system." *Id.*

The other cited references (e.g., *Fox* and *Goddard*) do not teach, suggest, or

disclose these claim recitations either. Therefore, no combination of the cited

references teaches, suggests, or discloses all recitations of independent claims 1 and 28.

B.   The references do not teach "testing the service in parallel operation on the earlier detected blade and the new blade."

Amended independent claims 1 and 28 also recite, among other things, "testing the service in parallel operation on the earlier detected blade and the new blade." The cited references do not teach this recitation, for reasons similar to those previously explained with respect to the 35 U.S.C. § 102(a) rejection of independent claim 21. In particular, while the Examiner correctly concludes that *Abbondanzio* does not teach or suggest this recitation, the Examiner incorrectly concludes that *Reimer* cures this deficiency. The cited passage of *Reimer* is replicated below in its entirety:

> When the spare server is up and running, any new users requiring the second type of operating system for the first type of applications, i.e. API(OS2), are directed to server S5 by the load balance unit, which is controlled by the control unit CU via the monitoring unit MU. No new users are directed to the failing server S3.

Reimer, p. 16, ll. 24-28.

Reimer is silent with regard to "testing the service in parallel operation," as claimed by Applicants. As exemplified in the cited passage, *Reimer* instead teaches directing users away from a failed server. *Id.* Such disclosure does not relate to "testing the service in parallel operation on the earlier detected blade and the new blade," as claimed by Applicants, and, therefore, does not teach or suggest the claim recitation.

The other cited references do not teach, suggest, or disclose this recitation either. Therefore, an additional basis exists for why no combination of the cited

references teaches, suggests, or discloses all recitations of independent claims 1, 21, and 28.

C.   The 35 U.S.C. § 103(a) rejections should be withdrawn.

As shown above, the cited references also do not teach, suggest, or disclose all recitations of amended independent claims 1, 21, and 28. Therefore, the differences between the cited references and the Applicants claims have not been properly ascertained. Accordingly, the Examiner has not clearly articulated a reason why one of ordinary skill in the art would have modified the cited references to achieve the subject matter of independent claims 1, 21, and 28. Dependent claims 2-19 and 25 each necessarily contain the recitations of amended independent claims 1 and 21. For at least this reason, no *prima facie* case of obviousness exists with respect to claims 1-20, 25, and 28. Applicants, therefore, respectfully request that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of claims 1-20, 25, and 28.

III.   Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner still have any questions regarding the patentability of Applicants' claims after reading the above, please call the undersigned representative below.
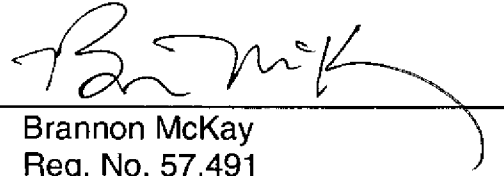
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 30, 2008

By: _____

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